

Amendments to the Drawings:

The attached sheet of drawings include changes to Figs. 2, 3, 7, 8 and 13.

These sheets, which include Figs. 2, 3, 6-7, 8 and 11-13, replace the original sheets including Figs. 2, 3, 6-7, 8 and 11 -13, to add the legend Prior Art.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

REMARKS

By the above amendment, a new title has been presented directed to the recording and reproducing of still picture information to which the present invention is directed, minor informalities in the specification have been corrected, claims 1 - 10 been canceled without prejudice or disclaimer of the subject matter thereof such that the rejections as set forth in the office action should be obviated, and new claims 11 - 18 have been presented.

With respect to the objection to the drawings, submitted herewith are replacement sheets in which Figs. 2, 3, 7, 8 and 13 have been designated as "Prior Art" as required by the Examiner. Accordingly acceptance of the drawings is respectfully requested.

With regard to the newly submitted claims, applicants note that claims 11 - 14 are directed to a recording medium on which information in terms of stream files and play list files are recordable and which operate in a particular manner, as discussed below. Claims 15 and 16 are directed to an information reproducing method for reproducing said picture information from the recording while claims 17 and 18 are directed to an information recording apparatus for enabling reproduction of still picture information from the recording medium. Applicants note that the specification at page 10, line 15 through page 11, line 12, and page 9, line 15 through page 20, line 9 in conjunction with Figs. 6, 9 and 14, for example, describe a recording medium on which still picture information is recordable and a method and apparatus for reproducing such still picture information from such recording medium. That is, the recording medium enables recording of stream files including still pictures and play list files which order still pictures to be played. Each of the play list files has one or more play items wherein each play item provides a presentation time, that is, a

presentation time of still pictures. More particularly, each play item as described at page 10, lines 24 - 28 in conjunction with Figure 6 has start information which indicates a presentation start time in the format of IN_time and end information which indicates a presentation in time in the format of OUT_time. For example, in a case where a still picture corresponds to each play item, each presentation time of the still picture can be provided, and therefore, in a presentation such a slide show, the reproducing time can be varied corresponding to each still picture. For example, in case of a presentation of an important still picture, a long time presentation can be provided, while, in case of a presentation of an unimportant still picture, a short time presentation can be provided. Applicants note that each of independent claims 11, 13, 15 and 17 recite such features for a recording medium which recording medium is utilized in the reproducing method and apparatus of the present invention.

Applicants submit that the recited features are not disclosed or taught in the cited art, as will become clear from the following discussion.

As to the rejection of claims 1 - 5 under 35 USC 101, this rejection is considered to be obviated by the cancellation of claims 1 - 5 and the presentation of new claims 11 - 14 directed to a recording medium wherein such claims recite the feature of stream files including still pictures and play list files which order still pictures to be played and recite the features of the play list files as including one or more play items with each of the play items including start information in recording a presentation start time and an information indicating a presentation end time with each of the play items indicating a presentation time of at least one still picture.

Applicants submit that the newly submitted claims are in compliance with 35 USC 101.

As to the rejection of claims 1 - 8 under 35 USC 102(e) as being anticipated by Tsumagari et al (US Patent No. 6,798,976) and the rejection of claims 9 and 10 under 35 USC 103(a) as being unpatentable over Tsumagari et al in view of Kageyama et al (US# 6,594,442), such rejections are considered to be obviated by the cancellation of claims 1 - 10 and the submission of new claims 11 - 18. Insofar as the newly submitted claims may be considered to be rejectable over the aforementioned cited art, such rejection is traversed and reconsideration and withdrawal of the rejection with respect to the newly submitted claims are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie

case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Turning first to Tsumagari, while this patent does disclose recording and reproducing of still picture information, applicants submit that Tsumagari does not disclose in the sense of 35 USC 102 or teach in the sense of 35 USC 103, the providing of a presentation time of still pictures for each play item of a play list which orders still pictures to be played, wherein each of the play items includes start information indicating a presentation start time and end information indicating a presentation end time for a still picture. In Tsumagari, while apparently a reproducing start time and a reproducing time (reproducing period) of a moving picture is disclosed, the reproducing time is a period in which the moving picture is recorded. If such disclosure is applied to a picture such as a still picture which has no recorded time (period), the start time of reproducing coincides with the end time of reproducing, and a reproducing time cannot be specified corresponding to each still picture. It is apparent that Tsumagari does not disclose or teach the recited features of claims 11 - 18. Thus, applicants submit that claims 11 - 18 patentably distinguish over Tsumaragari et al in the sense of 35 USC 102 and 35 USC 103, and all claims should be considered allowable.

As to the further combination of Kageyama with Tsumagari applicants submit that Kageyama does not overcome the aforementioned deficiencies of Tsumagari. Thus, while Kageyama also discloses recording and reproduction of still image data, this patent also fails to disclose providing of a presentation time of still pictures for each play item including a start information indicating a presentation start time and an end information indicating a presentation end time for a still picture. As such, Kageyama does not overcome the deficiencies of Tsumaragari and the combination fails to provide the claimed features as set forth in claims 11 - 18 of this application. Accordingly, applicants submit that all claims patentably distinguish over this

proposed combination of references in the sense of 35 USC 103, and all claims should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should be considered to be in compliance with 35 USC 101 and all claims patentably distinguish over the cited art and should now be considered allowable. Thus, issuance of an action of a favorable is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 520.43142X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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Attachments



FIG. 2 (PRIOR ART)

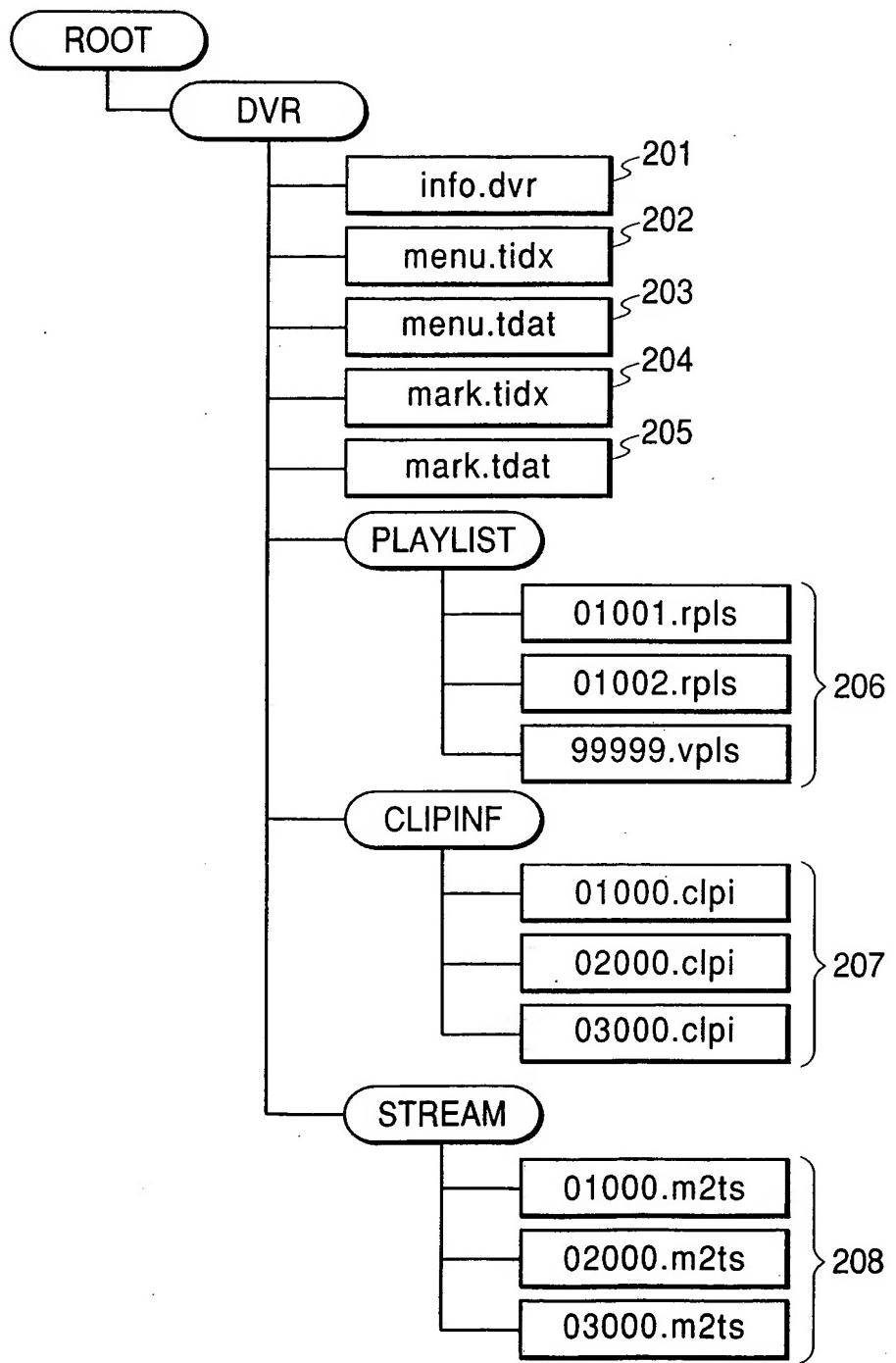




FIG. 3 (PRIOR ART)

Syntax	No.of bits	Mnemonic
xxxxx.rpls/yyy.ypls {		
version_number	8*4	bslbf
PlayList_start_address	32	uimsbf
PlayListMark_start_address	32	uimsbf
MakersPrivateData_start_address	32	uimsbf
reserved_for_future_use	180	bslbf
UIAppInfoPlayList()		
for(i=0;i<N1;i++) {		
padding_word	16	bsfbf
}		
PlayList()		
for(i=0;i<N2;i++) {		
padding_word	16	bslbf
}		
PlayListMark()		
for(i=0;i<N3;i++) {		
padding_word	16	bslbf
}		
MakersPrivateData()		
for(i=0;i<N4;i++) {		
padding_word	16	bslbf
}		



FIG. 6

Syntax	No.of bits	Mnemonic
PlayItem() {		
length	32	uimsbf
still_flag	1	bslbf
still_duration	8	bslbf
reserved_for_word_align	7	bslbf
Clip_Information_file_name	8 * 10	bslbf
ref_to_STC_id	8	uimsbf
IN_time	16	uimsbf
OUT_time	16	uimsbf
}		

FIG. 7 (PRIOR ART)

Syntax	No.of bits	Mnemonic
PlayListMark() {		
length	32	uimsbf
number_of_PlayList_marks	8 * 10	uimsbf
for(i=0;i<number_of_PlayList_marks;i++) {		
mark_type	8	uimsbf
mark_name_length	8	uimsbf
ref_to_PlayItem_id	16	uimsbf
mark_time_stamp	32	uimsbf
Entry_ES_PID	16	uimsbf
ref_to_thumbnail_index	16	uimsbf
mark_name	8 * 32	bslbf
}		
}		

FIG. 8 (FIGURE EIGHT)

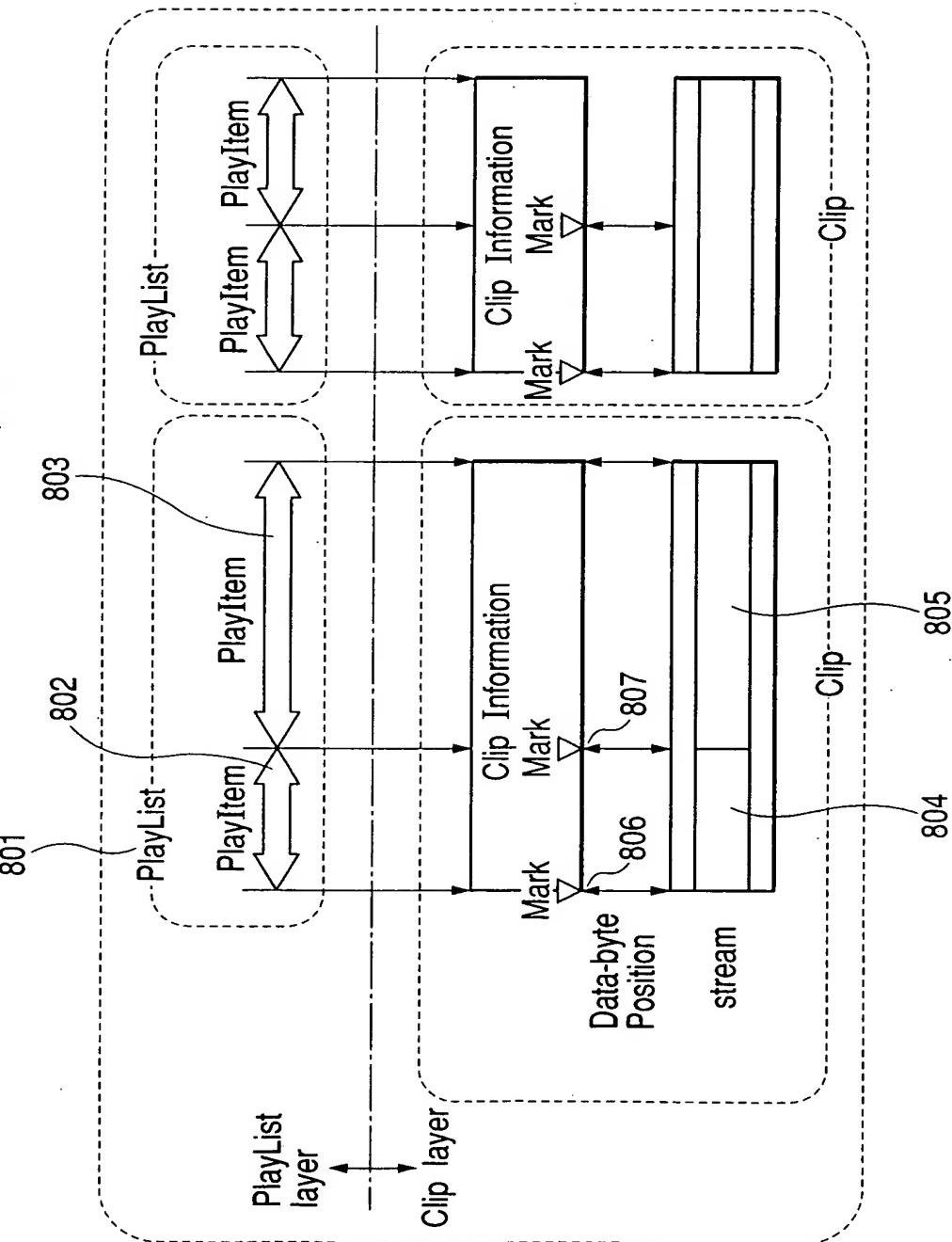


FIG. 11

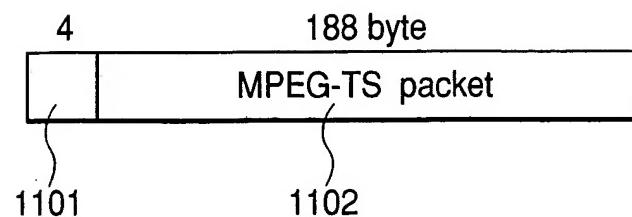


FIG. 12

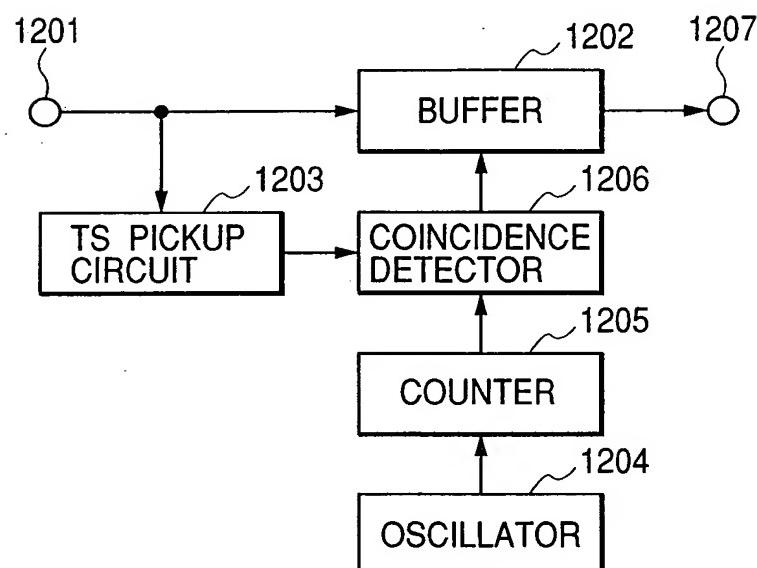


FIG. 13 (PRIOR ART)

